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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,639	07/27/2004	David R. Hall	66.0066	4638
38046	7590	11/30/2006	EXAMINER	
JEFFREY E. DALY INTELLISERV, INC 400 N. SAM HOUSTON PARKWAY EAST SUITE 900 HOUSTON, TX 77060			FULLER, ROBERT EDWARD	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/710,639		HALL ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Robert E. Fuller		3672	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 21-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 21-24 and 26-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. In view of applicant's amendment, examiner has changed the rejection of the claims based upon prior art which was previously cited. Therefore, this action has not been made final. Also, objections to the drawings and to the claims made in the previous office action have been withdrawn.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1- 8, 21-24, and 26-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Meador (US 4,605,268).

With regard to claim 1, Meador discloses an apparatus for retrofitting a section of drill pipe with a transmission line, having an insert comprising a mount portion (142) which is mounted in a shoulder of the box end of a drill pipe, and a slide portion (128) which slides over the collet arms (158) of the box end insert. Meador further teaches a transmission element (134) mounted in the slide portion and a biasing element (160) which effects a bias between the slide portion and mount portion, by outwardly biasing the two halves of the collet arms. The insert narrows a central bore of the drill pipe.

With regard to claims 3 and 4, channels (140 and 152) travel through the slide and mount portions to accommodate transmission lines. Transmission lines are routed

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within the channels and are capable of flexing when the mount portion slides with respect to the slide portion.

With regard to claim 5, the biasing element is an elastomeric material.

With regard to claim 6, the slide portion is substantially cylindrical and has an annular mating surface configured to contact a corresponding annular mating surface.

With regard to claim 7, the transmission elements (134 and 148) are annular.

With regard to claim 8, the slide portion is prevented from sliding by the outward bias of the biasing member (160) and the collet arms (158).

With regard to claim 22, the insert comprises a flange (206) adapted to sit against a shoulder of the drill pipe.

With regard to claims 23 and 24, the insert comprises slots (189) in combination with a "narrowing of the wall of the [insert] (i.e. tapering of the insert)" which "provide a degree of resiliency of the [insert] to accommodate expansion and retraction of the [insert]" (column 8, lines 45-51).

With regard to claim 26, Meador discloses an apparatus for retrofitting a section of drill pipe with a transmission line, comprising a pin end insert (128) comprising a first transmission element (134), and inserted into a pin end of a drill pipe, narrowing the central bore. Meador further teaches a box end insert (142) comprising a second transmission element (148) insertable into a shoulder of the box end of the drill pipe.

With regard to claim 27, the box end insert (142) comprises a mount portion, as it is mounted on a shoulder of the box end, and the pin end comprises a slide portion, as it slides over the collet arms (158) of the box end insert.

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With regard to claim 28, a biasing element (160), which is a strip of "resilient material," causes the collet arms (158) of the mount portion to be biased outwardly against the receptacles (174) of the slide portion.

With regard to claim 29, the first transmission element (134) is mounted to the slide portion.

With regard to claims 30 and 31, channels (140 and 152) travel through the slide and mount portions to accommodate transmission lines. Transmission lines are routed within the channels and are capable of flexing when the mount portion slides with respect to the slide portion.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meador.

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Meador fails to disclose the inserts being smooth. However, it would have been considered obvious to one of ordinary skill in the art, to have provided smoothed inserts, as it would have been undesirable to have any sort of flow restriction within the bore of the inserts. Furthermore, any insert within the bore of a drill pipe would eventually have developed a smoothed surface, due to the highly erosive conditions within drill pipe.

***Allowable Subject Matter***

6. Claim 25 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1 and 26 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert E. Fuller whose telephone number is 571-272-0419. The examiner can normally be reached on Monday thru Friday from 8:00 AM - 5:30 PM. The examiner is normally out of the office every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

11/22/2006  
REF



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